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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,737	05/03/2001	Daniel Schoeffler	SDA-1	8033

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EXAMINER

NGUYEN, PHUOC H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/848,737	SCHOEFFLER, DANIEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Phuoc H. Nguyen	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This communication is responsive to Amendment filed December 12, 2005.
2. Claims 1-67 are pending in this application. In Amendment, claims 66-67 are withdrawn.

This Office Action is made non-final after a RCE filed December 12, 2005.

#### ***Response to Amendment***

3. The amendment filed 12/12/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amended limitations cited in independent claims 1 and 33 as “at least the first address and communication contents to a forwarding service separate from the sender’s service provider” in lines 4-5 are considered as new subject matter because page 14 last paragraph and page 8 second paragraph do not clearly disclose the forwarding service is separated from the sender’s service provider (e.g. ISP) but rather the specification disclose the forwarding service is separated from standard communications channel provided by the first communications services. As interpreted by examiner, the forwarding service and the old address service is not on a same communication channel as a logical channel.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Response to Arguments*

4. Applicant's arguments filed 12/12/2005 have been fully considered but they are not persuasive.

The applicant argues in pages 15-16 for independent claims 1 and 33 that the cited reference by Tsuei fails to disclose the limitations cited in the claimed invention particularly the limitation of a sender sends the entire communication through a service provider to a forwarding service separate from the service provider and the forwarding service forwards the communication on the a second address.

The examiner respectfully submits that the cited reference clearly discloses every single limitation cited in the claimed invention. As mentioned above and below, the limitations cited in the pre-amble has not been given any patentable weight and also the limitation "separated from the service provider" is considered as a new subject matter because it has not found in the original specification page 8 second paragraph or page 14 first paragraph. Even that, Figure 3 clearly discloses the limitations of the claimed invention. The forward service as mail forwarder 114 is separated from the sender ISP communication which received a whole email from sender 110 and lookup second new address from EAMS 330 if fails. It then sends to the sender 110 the new address for notification purposes, the mail forwarder sends to the new recipient directly the intended email as clearly seen in Figure 4 and col. 10 lines 30-50.

In addition to the response of applicant's arguments, the recitation limitation "indirectly forwarding a communication from a sender.... and having an address different from that of the recipient" in the pre-amble of claims 1 and 33 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight

where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6,12-17,20,21,23,24,26,27,29-39,45-50,53,54,56,57,59,60, and 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei U. S. Patent 6,654,779.

7. Regarding claims 1, 33, and 36, Tsuei discloses a method of indirectly forwarding a communication from a sender using a service provider to a recipient where address for the recipient is known or believed to be temporarily or permanently invalid, by sending the communication comprising at least the first address and communication contents to a forwarding service separate from the sender's provider and having an address different from that of the recipient (Abstract; and Figure3), comprising, the forwarding service the steps of receiving the communication (e.g. mail forwarder 114 receiving communication from sender 110); the

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forwarding service looking up at least the first address in a database (Figure 3, mail forwarder 114 send request to EAMS 330 for look up email address); the forwarding service retrieving at least one second address from the database, which second address is associated with the first address (e.g. Mail forwarder 114 receive second email address from EAMS 330); the forwarding service sending the communication to the second address (col. 10 lines 31-47).

8. Regarding claims 2 and 35, Tsuei discloses in which the first address is sent to the forwarding service as part of a forwarding address (Figure 4).

9. Regarding claims 3 and 37, Tsuei discloses the first address is a part of the communication, and further comprising the step, after step a, of extracting (inherently) the first address from the communication (Figure 4; col. 9, lines 59-64).

10. Regarding claim 4, Tsuei discloses the old address for the recipient is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, an IP address plus at least one time and/or date and/or duration, a file name, a file name plus a location, an instant messaging ID, a pager ID, a personal digital assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).

11. Regarding claims 5 and 38, Tsuei discloses the second address (e.g. new email address) is selected from a group comprising: a telephone number, an e-mail address, a postal address, a uniform resource locator, an IP address, a file name, a file name plus a location, an messaging ID, a pager ID, a personal digital assistant ID, a cellphone ID, a cable terminal ID, a direct broadcast terminal ID, a telex number, a teletype number, and an online chat user ID (Figure 3, 340).

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12. Regarding claims 6 and 39, Tsuei discloses the communication is selected from a group comprising telephone calls; electronic mail messages, postal mail, instant messaging communications, internet protocol communications, web pages, computer file transfer protocols, video transmissions, paging transmissions, personal digital assistant transmissions, cellphone transmissions, cable transmissions, direct broadcast transmissions, telex and teletype communications, and online chat transmissions (Figure 3, internet 130).

13. Regarding claims 12 and 45, Tsuei discloses there is more than one second address associated with the first address, and step d is performed for more than one of the second addresses associated with the first address (col. 7, last paragraph through col. 8, 1<sup>st</sup> paragraph).

14. Regarding claims 13 and 46, Tsuei discloses if there is a password in the database associated with the new address, prior to forwarding the communication requesting a password from the sender, receiving a password supplied by the sender, comparing the password supplied by the sender to the password in the database, and only performing the sending step d if the comparison is successful (e.g. Figure 3, before the sender 110 sends an email message to the recipient it must authenticated to the sender ISP (e.g. forwarding service). The authentication process will require to have an unique id and a password. Therefore, the forwarding service has to verify the password before performing the sending service.).

15. Regarding claims 14 and 47, Tsuei discloses sending a communication to the sender with identifying material associated with the more than one second addresses retrieved in step c and requesting the sender to choose from among the more than one second addresses, accepting a choice from the sender selecting at least one of the more than one second addresses, sending the communication to the selected at least one of the more than one second addresses (col. 7, lines

31-52).

16. Regarding claims 15 and 48, Tsuei discloses the at least one second address was registered by the recipient (Figure 5).

17. Regarding claims 16,17,49, and 50, Tsuei discloses the recipient periodically updates the at least one second address, and periodic updating is done automatically (col. 6, lines 30-44).

18. Regarding claims 20 and 53, Tsuei discloses at least one second address was retrieved by the forwarding service from a source other than the recipient (Figure 4).

19. Regarding claims 21 and 54, Tsuei discloses the forwarding step (d) further comprises the step of including additional information in the communication (Figure 3; and col. 6, last paragraph through col. 7, 1<sup>st</sup> paragraph).

20. Regarding claims 23,24,55 and 57, Tsuei discloses the step of sending a confirming communication back to the sender, and the confirming communication comprises at least the second address to which the communication was forwarded (col. 7, lines 41-46).

21. Regarding claims 26 and 59, Tsuei discloses the first address and at least one second address are addresses in the same medium of communications (Abstract).

22. Regarding claims 27 and 60, Tsuei discloses in which the first address and at least one second address are addresses in different media of communications (Figure 3, 340).

23. Regarding claims 29 and 62, Tsuei discloses if the second retrieved in step c is invalid, of using the second address as a first address, and repeating the method from step b (Figure 4, 470 to 420 to 440).

24. Regarding claims 30 and 63, Tsuei discloses the communication is sent to the forwarding service by a server associated with a service provider (Figure 4).



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25. Regarding claims 31 and 64, Tsuei discloses the server is associated with the sender, and the mail server automatically sends the communication to the forwarding service when the communication is returned as undeliverable (Figure 4, 440).

26. Regarding claim 32 and 65, Tsuei discloses the server is a mail server associated with the first address associated with the recipient, and the mail server automatically sends the communication to the forwarding service when the mail server cannot deliver the communication to the first address (Figures 3 and 4).

### *Claim Rejections - 35 USC § 103*

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 7-11,18-19,28,40-44,51-52, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei in view of Fuisz U.S. Patent 6,643,688.

29. Regarding claims 7-11, and 40-44, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned.

Fuisz reference discloses the step of selecting one of the new addresses based on selection criteria such as a password supplied by the sender, a time of day, a priority ranking supplied by the recipient, and the second address returned is a second address having the highest priority, and a next-higher priority second address until a valid second address is found or all second addresses are returned (col. 2, lines 8-12; col. 2, lines 51-61; col. 3, lines 1-31; and col. 4, lines 37-60).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to forward an email message based upon the condition selection technique; as a result, it ensures that email will continue to find its way to the intended recipient.

30. Regarding claims 18-19 and 51-52, Tsuei discloses the at least one second address was registered by the recipient; however, Tsuei fails to teach the recipient specifies at least one sender from whom the recipient does not wish to receive or not receive communications, and the sending step d of the method further comprises the step of not sending or sending communications to the at least one sender specified by the recipient.

Fuisz reference discloses the filtering technique which allow user's to create their own filter whether the user's want to receive or not receive message from a certain sender(s) (col. 8, lines 23-36).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to apply the filtering technique Tsuei's invention to allow user with more flexibility to manage their email account.

31. Regarding claims 28 and 61, Tsuei discloses retrieving at least one second address from the database, which second address is associated with the old address; however, Tsuei fails to teach counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit.

Fuisz reference discloses counting the number of communications forwarded for a sender in a selected time period, and not forwarding communications if the sender sends more communications to be forwarded during the selected time period than a selected limit (col. 3, 1<sup>st</sup> paragraph).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Fuisz's teaching into Tsuei's method to count the number of forwarded e-mail so it can bills the user.

32. Claims 22,25,55, and 58, rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei.

Tsuei discloses sending the communication to the second address further comprises the step of including additional information in the communication, and send the confirmation to the sender; however, Tsuei fails to teach additional information is advertising, the confirming communication also comprises additional information at least in the form of advertising.

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to provide additional information such as advertising attach to the message to attract sender attention to a product or business.

***Conclusion***

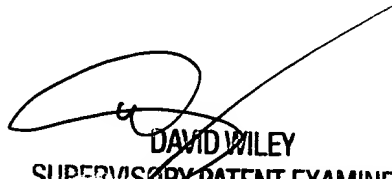
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen  
Examiner  
Art Unit 2143

February 27, 2006

  
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